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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/893,829

06/28/2001

Raja Krishnaswamy

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5228

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10/02/2006

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EXAMINER

CHANKONG, DOHM

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/893,829

Applicant(s)

KRISHNASWAMY ET AL.

Examiner

Dohm Chankong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-15, 17-24, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-15, 17-24, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1> This action is in response to Applicant's request for continued examination. Claims 1, 10, 14, 15, 17, 23, 24 and 27 are amended. Claims 1-8, 10-15, 17-24, 26 and 27 are presented for further examination.

2> This is a non-final rejection.

#### *Continued Examination Under 37 CFR 1.114*

3> A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6.13.2006 has been entered.

#### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4> Claims 24 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 24 and 26 are directed towards a data packet. There are two groups of computer-related products: functional descriptive material and non-functional descriptive material. Data packets are considered to be non-functional descriptive

material because data packets are merely an arrangement of data. See MPEP §2106(IV)(B)(1). Non-functional descriptive material per se is an abstract idea, and therefore is not statutory. Such descriptive material is not a process, machine, manufacture or composition of matter. See MPEP §2106(IV)(B)(1)(b). Thus, claims 24 and 26 are directed towards non-statutory subject matter and are rejected under §101.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5> Claims 1-8, 10-15, 17-23 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The information contained in the disclosure of an application must be sufficient to inform those skilled in the relevant art how to both make and use the claimed invention. See MPEP §2164. The test for enablement centers on whether any person skilled in the art can make and use the invention without undue experimentation. See MPEP §2164.01. Factors for determining whether undue experimentation is necessary include, but are not limited to: the breadth of the claims, the nature of the invention, the state of the prior art, the level of one of ordinary skill, the level of predictability in the art, the amount of direction provided

by the inventor, the existence of working examples, the quantity of experimentation needed to make or use the invention based on the content of the disclosure. MPEP §2164.01(a). If little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling. See MPEP §2164.03.

Here, Applicant has amended the independent claims to include a feature whereby remote method call invocation is optimized using the process of machine learning. Based on the aforementioned factors, this feature is not enabled by Applicant's specification. More specifically, the Office asserts that undue experimentation would be required to make and use machine learning for the purpose of optimizing remote method call invocation.

The state of the prior art at the time of Applicant's filing date is entirely absent as to combining remote method invocation or machine learning, and in particular using machine learning to optimize invocation. As understood by the Office, machine learning, a subset of artificial intelligence, generally is related to the process by which computers use previous results to "learn" or improve subsequent iterations. The process of optimizing remote method invocation (what is optimized, how is invocation optimized) is unclear and Applicant's application provides no guidance as to a proper interpretation. An examination of the state of the prior art reveals that these disparate concepts have not been utilized together to produce the claimed limitation.

One of ordinary skill in the art might have known of the separate principles of remote method invocation and machine learning, but one skilled in the art would not have known how to combine the two principles to optimize the invocation process. Thus, since there is a

dearth of knowledge in the state of the art, the amount of guidance required in Applicant's application increases.

However, Applicant's specification merely recites the feature as stated in the claims with no discussion as to make or use the claimed feature. Applicant's specification provides no direction as to: (1) machine learning in general; (2) how machine learning would optimize remote method invocation; and (3) how remote method invocation would be optimized. In other words, aside from a general statement of use, Applicant's specification lacks any teaching that would be instructive to one skilled in the art to make the claimed invention.

Therefore, since Applicant's specification is entirely deficient in providing any teaching with respect to this feature and the state of the prior art at the time the invention was filed reveals that machine learning is not typically used with optimizing remote method call invocation, undue amount of experimentation would be required to make and use Applicant's claimed invention. The claims fail to comply with the enablement requirement as required by 35 U.S.C §112, first paragraph.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mason et al, U.S Patent No. 6.253.253;

Guthrie et al, U.S Patent No. 6.385.661;

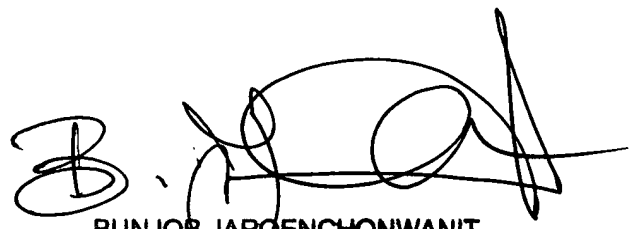
Sanchez, II, U.S Patent No. 6.915.520.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Tuesday-Friday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC



BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER